



# UNITED STATES PATENT AND TRADEMARK OFFICE

X1

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,294	07/17/2003	Reid Lee	5150-40801	2482
7590	07/27/2006		EXAMINER	
Jeffrey C. Hood Meyertons, Hood, Kivlin, Kowert & Goetzel PC P.O. Box 398 Austin, TX 78767				HAQ, NAEEM U
		ART UNIT		PAPER NUMBER
				3625

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/621,294	LEE, REID
	<b>Examiner</b>	<b>Art Unit</b>
	Naeem Haq	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 May 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-80 is/are pending in the application.
  - 4a) Of the above claim(s) 77-80 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-76 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 7/17/2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

This action is in response to the Applicant's amendment filed on May 3, 2006.

New claims 76-80 have been added. Claims 1-80 are pending and will be considered for examination.

### ***Election/Restrictions***

Newly submitted claims 77-80 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 77-80 are directed to a first and a second user configuring a system over a network. The originally presented claims did not have a "second user". Thus, the design and operation of the invention in claims 77-80 is different from and not connected to the invention in claims 1-76 which does not have a second user. Furthermore, the invention of claims 77-80 is not an obvious variation of the invention of claim 1-76 because the "second user" is not required in claims 1-76.

Since the Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 77-80 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Drawings***

Figures 1 and 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. Figure 1 shows nothing more than a client computer connected to a server via the Internet. Figure 5 shows a measurement system. However, the Examiner notes that this figure appears to be the same as Figures 1 and 2 of US Patent 5,710,727. Furthermore, in the parent application 09/498,698 (now US patent 6,985,876 B1) the same Figures 1 and 5 were designated as prior art. Appropriate action is required.

***Final Rejection***

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of IBM Technical Disclosure Bulletin hereafter referred to as “IBM” and further in view of Motomiya et al (US 6,083,267) hereafter referred to as “Motomiya”.**

Referring to claim 1: Henson teaches a method for enabling a user to configure a system in an e-commerce system, wherein the e-commerce system includes a client

system coupled through a network to an electronic commerce server (*Figure 2, "44", "38", and "10"; col. 5, line 66 – col. 6, line 4*), the method comprising:

- receiving a request from a user via the network of the client system to configure the system, wherein the system includes one or more customizable components (*column 4, lines 36-52; Figure 3A, "Hard Drive", "Video Card"; Figure 3B, "Network Card"*);
- determining customizable component selections for at least one of the one or more customizable components of the system in response to user input (*col. 6, lines 18-30; col. 7, lines 39-56; Figure 3A, "75" and "76"; Figure 3B, "86"*), wherein said determining customizable component selections comprises:
  - receiving user input via the network selecting a first customizable component option for the first customizable component, wherein the user input selecting the first customizable component option comprises the customizable component selection for the first customizable component (*col. 6, lines 18-30; col. 7, lines 39-56; Figure 3A, "75" and "76"; Figure 3B, "86"*);
  - wherein the customizable component selections applied to the system specify a configured system (*col. 7, line 57 – col. 8, line 6*).

Henson does not teach providing an image of the system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the system. However, IBM discloses a method of configuring a system that provides an image of the system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the system (*Page 368*:

*"The 'Visual Configurator' (VC) concept presents one with a picture of an empty machine, and through the use of a mouse, the user is presented with menus of potential device that can be installed in various locations of the machine under configuration.";* Page 369, Figure 2). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of Hanson. One of ordinary skill in the art would have been motivated to do so in order to provide a "...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate..." as taught by IBM (Page 369). Henson does not teach receiving user input selecting an image of a first customizable component which is visually depicted in the image of the system, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration. However, IBM teaches a method of configuring a system that receives user input selecting an image of a first customizable component which is visually depicted in the image of the system, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration (page 370, lines 17-19: "...the VC allows one to point and click the mouse for a desired device in any order the user wishes." and lines 42-46: "By clicking the mouse over a particular location in the window that graphically displays the layout of the inside of the machine, a list of options that will fit into that particular location is displayed. For example, if one clicks the mouse over an DASD bay, a list of DASD devices that are allowed in that slot are presented in a menu.") Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of Hanson. One of ordinary skill in the art would have been motivated to do so in order to provide a "...user with visual

*feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate..."* as taught by IBM (*Page 369*). The cited prior art does not teach that the image is provided to the client system via a network, or that the user selects an image via a network. However, Motomiya teaches an Internet-based configuration method and program that allows a user to configure a variety of products (*Abstract*) and where the image is provided to the client system via a network and where the user selects an image via a network (*Figures 5A – Figure 6B*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a display of the product as it was being configured.

Referring to claim 2: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. Furthermore, Henson provides a text display of the final configured system (*Figure 6, item "104"*) and shows an image of a "Dell Dimension XPS R" computer system (*Figures 3A and Figure 4, item "70"*). Moreover, Motomiya teaches an Internet-based configuration method and program that allows a user to configure a variety of products (*Abstract*). Motomiya teaches displaying an image of the final customized product to the client system wherein the image of the customized product visually depicts the customizable component selections of the user at their respective locations on the image of the customized product (*column 5, lines 41-67; column 6, lines 1-35; Figure 6A, item 63; Figure 6B*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya

into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a display of the final configured product before the customer placed an order for the product.

Referring to claim 3: The cited prior art teaches or suggests all the limitations of claim 2 as noted above. Furthermore, Motomiya teaches that providing the image of the configured system includes providing customizable component selection images corresponding to the customizable component selections of the user (*Figure 6A, item "62"; Figure 6B*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the invention of Henson and IBM. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a display of the final configured product with the customized components before the customer placed an order for the product.

Referring to claim 4: The cited prior art teaches or suggests all the limitations of claim 3 as noted above. Furthermore, Motomiya teaches visually depicting a subset of the customizable component selection images at their respective locations on the image of the configured product (*Figures 5A-6B*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the invention of Henson and IBM. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a display of the final configured product with the customized components at their respective locations before the customer placed an order for the product.

Referring to claim 5: The cited prior art teaches or suggests all the limitations of claim 2 as noted above. Furthermore, Motomiya teaches providing text corresponding to the customizable component selections of the user; wherein the text is displayed in the image of the configured system (*Figure 6B: "Equipment" and "Fasteners"*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the invention of Henson and IBM. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a display of the final configured product with the customized components at their respective locations before the customer placed an order for the product.

Referring to claim 6: The cited prior art teaches or suggests all the limitations of claim 2 as noted above. Furthermore, Motomiya teaches that the image of the configured product is viewable by the user and used by the user to evaluate and confirm the customizable component selections (*Figures 5A-6B*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method and program of cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see the configured product before placing an order.

Referring to claim 7: The cited prior art teaches or suggests all the limitations of claim 2 as noted above. Furthermore, Henson teaches receiving one or more new customizable component selections for at least one of the one or more customizable components of the configured system after said providing the image of the configured

system to the client system, wherein the new customizable component selections applied to the configured system specify a new configured system (*Figure 6, "104" "Edit"*). The cited prior art does not teach providing an image of the new configured system, wherein the image of the new configured system visually depicts the new customizable component selections of the user. However, Motomiya teaches providing an image of the configured system, wherein the image of the configured system visually depicts the customizable component selections of the user (*Figure 6A, item "62"; Figure 6B*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the invention of Henson and IBM. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a display of the final configured product with the customized components before the customer placed an order for the product.

Referring to claim 8: The cited prior art teaches or suggests all the limitations of claim 7 as noted above. Furthermore, IBM teaches receiving user input selecting a first customizable component (*page 370, lines 17-19*: "...the VC allows one to point and click the mouse for a desired device in any order the user wishes."); providing a menu of possible options for the first customizable component to the client system for display after the user input selecting the first customizable component; receiving user input selecting one of the possible options for the first customizable component (*page 370, lines 42-46*: "By clicking the mouse over a particular location in the window that graphically displays the layout of the inside of the machine, a list of options that will fit into that particular location is displayed. For example, if one clicks the mouse over an DASD bay, a list of DASD devices that are allowed in that slot are presented in a menu."); Page 368: "The 'Visual Configurator' (VC) concept presents one with a picture of an empty

*machine, and through the use of a mouse, the user is presented with menus of potential device that can be installed in various locations of the machine under configuration.”; Page 369, Figure 2). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide a “...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate...” as taught by IBM (Page 369).*

Referring to claims 9 and 10: The cited prior art teaches or suggests all the limitations of claim 1 as noted above. Furthermore, IBM teaches receiving user input indicating that a position of a cursor of the client system overlaps a location of the image of the first customizable component displayed in the image of the system (page 370, lines 42-46: *“By clicking the mouse over a particular location in the window that graphically displays the layout of the inside of the machine, a list of options that will fit into that particular location is displayed. For example, if one clicks the mouse over an DASD bay, a list of DASD devices that are allowed in that slot are presented in a menu.”; Page 368: “The ‘Visual Configurator’ (VC) concept presents one with a picture of an empty machine, and through the use of a mouse, the user is presented with menus of potential device that can be installed in various locations of the machine under configuration.”; Page 369, Figure 2).* Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide a “...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate...” as taught by IBM (Page 369).

Referring to claim 11: The cited prior art teaches or suggests all the limitations of claim 10 as noted above. Furthermore, IBM teaches that the menu comprising the

customizable component options includes text (i.e. list) indicating the customizable component options (*page 370, lines 42-46; Figure 2*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide a “*...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate...*” as taught by IBM (*Page 369*).

Referring to claims 12 and 14: The cited prior art teaches or suggests all the limitations of claim 10 as noted above. The cited prior art does not teach that the menu comprising the customizable component options includes images indicating the customizable component options. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of receiving and providing would be performed the same regardless of what was displayed in the menu of the cited prior art. The differences between the Applicant’s invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display an image of the component in the menu of the cited prior art because such content does not

functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 13: The cited prior art teaches or suggests all the limitations of claim 10 as noted above. Furthermore, IBM teaches the menu is operable to be displayed proximate to the location of the image of the first customizable component (*Figure 2*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide a “*...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate...*” as taught by IBM (*Page 369*).

Referring to claim 15: The cited prior art teaches or suggests all the limitations of claim 10 as noted above. Furthermore, IBM teaches providing customizable component options corresponding to the customizable component options of the first customizable component; and receiving user input selecting a first customizable component option image corresponding to the first customizable component option. IBM teaches in Figure 2 that the user selects the image of “slot 1” and is presented with a menu having a set of component options for configuring “slot 1”. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide a with visual feedback of the customizable component options for a first customizable component as taught by IBM (*Page 369*). IBM does not teach that the component options are images. However, the

Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of receiving and providing would be performed the same regardless of what was displayed in the menu of the cited prior art. The differences between the Applicant's invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display an image of the component in the menu of the cited prior art because such content does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 17: Henson teaches a method for enabling a user to configure a system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server (*Figure 2, "44", "38", and "10"; col. 5, line 66 – col. 6, line 4*), the method comprising:

- receiving a request from a user of the client system to configure the system, wherein the system includes one or more customizable components (*column 4, lines 36-52; Figure 3A, "Hard Drive", "Video Card"; Figure 3B, "Network Card"*);
- receiving customizable component selections for at least one of the one or more customizable components of the system in response to user input (*col. 6, lines 18-*

30; col. 7, lines 39-56; Figure 3A, "75" and "76"; Figure 3B, "86"), wherein said receiving customizable component selections comprises:

receiving user input selecting a first customizable component option for the first customizable component, wherein the user input selecting the first customizable component option comprises the customizable component selection for the first customizable component (col. 6, lines 18-30; col. 7, lines 39-56; Figure 3A, "75" and "76"; Figure 3B, "86");  
wherein the customizable component selections applied to the system specify a configured system (col. 7, line 57 – col. 8, line 6).

Henson does not teach providing an image of the system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the system. However, IBM discloses a method of configuring a system that provides an image of the system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the system (Page 368: "*The 'Visual Configurator' (VC) concept presents one with a picture of an empty machine, and through the use of a mouse, the user is presented with menus of potential device that can be installed in various locations of the machine under configuration.*"; Page 369, *Figure 2*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide a "...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate..." as taught by IBM (Page 369). Henson does not teach receiving user input

selecting an image of a first customizable component which is visually depicted in the image of the system, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration. However, IBM teaches a method of configuring a system that receives user input selecting an image of a first customizable component which is visually depicted in the image of the system, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration (*page 370, lines 17-19: "...the VC allows one to point and click the mouse for a desired device in any order the user wishes."* and *lines 42-46: "By clicking the mouse over a particular location in the window that graphically displays the layout of the inside of the machine, a list of options that will fit into that particular location is displayed. For example, if one clicks the mouse over an DASD bay, a list of DASD devices that are allowed in that slot are presented in a menu."*) Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of Hanson. One of ordinary skill in the art would have been motivated to do so in order to provide a "...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate..." as taught by IBM (Page 369). The cited prior art does not teach that the system displayed and configured is a "measurement" system. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of receiving and providing would be performed the same regardless of what system was displayed on the computer screen. The differences between the content of what is displayed on the computer screen of the Applicant's invention and the prior art are

merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any system in the invention of the cited prior art because what is displayed on the computer screen does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention. The cited prior art does not teach that the image is provided to the client system via a network, or that the user selects an image via a network. However, Motomiya teaches an Internet-based configuration method and program that allows a user to configure a variety of products (*Abstract*) and where the image is provided to the client system via a network and where the user selects an image via a network (Figures 5A – Figure 6B). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Motomiya into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide the customer with a display of the product as it was being configured.

Referring to claims 18, 34, 56, 66, 73: Claims 18, 34, 56, 66, and 73 are rejected under the same rationale as set forth above in claim 2.

Referring to claims 19 and 35: Claims 19 and 35 are rejected under the same rationale as set forth above in claim 3.

Referring to claims 20 and 36: Claims 20 and 36 are rejected under the same rationale as set forth above in claim 4.

Referring to claims 21 and 37: Claims 21 and 37 are rejected under the same rationale as set forth above in claim 5.

Referring to claims 22 and 38: Claims 22 and 38 are rejected under the same rationale as set forth above in claim 6.

Referring to claims 23 and 39: Claims 23 and 39 are rejected under the same rationale as set forth above in claim 7.

Referring to claims 24 and 40: Claims 24 and 40 are rejected under the same rationale as set forth above in claim 8.

Referring to claims 25, 26, 41, 42, and 53: Claims 25, 26, 41, 42, and 53 are rejected under the same rationale as set forth above in claims 9 and 10.

Referring to claims 27 and 43: Claims 27 and 43 are rejected under the same rationale as set forth above in claim 11.

Referring to claims 28 and 44: Claims 28 and 44 are rejected under the same rationale as set forth above in claim 12.

Referring to claims 29, 30, 45, 46, and 54: Claims 29, 30, 45, 46, 54 are rejected under the same rationale as set forth above in claims 13 and 14.

Referring to claims 16, 31, 32, 47, 48, 55, 64, 65, 71, and 72: Claims 16, 31, 32, 47, 48, 55, 64, 65, 71, and 72 are rejected under the same rationale as set forth above in claim 15.

Referring to claims 33, 49, 50, 52, 69, and 76: Claims 33, 49, 50, 52, 69, and 76 are rejected under the same rationale as set forth above in claim 1.

Referring to claims 51 and 62: Claims 51 and 62 are rejected under the same rationale as set forth above in claim 17.

Referring to claim 57: The cited prior art teaches or suggests all the limitations of claim 52 as noted above. Furthermore, Henson teaches receiving payment information for the configured system to purchase the configured system (*Figure 10, "124"*).

Referring to claim 58: The cited prior art teaches or suggests all the limitations of claim 57 as noted above. Furthermore, Henson teaches providing the configured system to a user of the client computer after said receiving payment information for the configured system to purchase the configured system (*col. 11, lines 25-30; col. 12, lines 40-41*).

Referring to claim 59: The cited prior art teaches or suggests all the limitations of claim 52 as noted above. The cited prior art does not teach that the system displayed and configured is a "measurement" system. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of receiving and providing would be performed the same regardless of what system was displayed on the computer screen. The differences between the content of what is displayed on the computer screen of the Applicant's invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217

*USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)* also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any system in the invention of the cited prior art because what is displayed on the computer screen does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claims 60 and 61: Claims 60 and 61 are rejected under the same rationale as set forth above in claim 1.

Referring to claim 63: The cited prior art teaches or suggests all the limitations of claim 62 as noted above. Furthermore, IBM teaches providing a menu comprising options for the device for display on the client computer after receiving user input selecting the image of the device (*page 370, lines 42-46*: “*By clicking the mouse over a particular location in the window that graphically displays the layout of the inside of the machine, a list of options that will fit into that particular location is displayed. For example, if one clicks the mouse over an DASD bay, a list of DASD devices that are allowed in that slot are presented in a menu.*”; *Page 368*: “*The ‘Visual Configurator’ (VC) concept presents one with a picture of an empty machine, and through the use of a mouse, the user is presented with menus of potential device that can be installed in various locations of the machine under configuration.*”; *Page 369, Figure 2*). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide a “*...user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate...*” as taught by IBM (*Page 369*).

Referring to claims 67 and 74: Claims 67 and 74 are rejected under the same rationale as set forth above in claim 57.

Referring to claims 68 and 75: Claims 68 and 75 are rejected under the same rationale as set forth above in claim 58.

Referring to claim 70: Claim 70 is rejected under the same rationale as set forth above in claim 63.

### ***Response to Arguments***

Applicant's arguments with respect to the Examiner's objection to Figures 1 and 5 have been fully considered but they are not persuasive. The Applicant has argued that Figures 1 and 5 are not prior art because they illustrate a means for some embodiments of the instant Application. The Examiner respectfully disagrees and notes that in the parent application 09/498,698 (now US patent 6,985,876 B1) the same Figures 1 and 5 were designated as prior art. For this reason, the Examiner maintains the objection to Figures 1 and 5.

Applicant's arguments with respect to the rejection of claims 13 and 29 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. This rejection is withdrawn.

Applicant's arguments with respect to the rejection claims 1, 9-17, 25-33, 41-55, 57-65, 67-72, 74, and 75 under 35 U.S.C. 103 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant has also argued that the Visual Configurator taught by IBM resides on a single machine and therefore teaches away from the feature of claim 1. The Examiner respectfully disagrees and notes that the rejection of claim 1 is based on three references. The Applicant cannot show nonobviousness by attacking references individually. *In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.* See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, it well within the level of one of ordinary skill in the art to port a DOS based application to any other platform such as the Internet. To support this point of obviousness, the Examiner cites the following references:

- "PenRight unleashes Windows tool" by Diana Hwang hereafter referred to as "Hwang";
- "Sequent exec leaves to 'take a shot at Internet gold rush'" by Anita Marks hereafter referred to as "Marks"

Hwang discloses that it is well known in the art to port a DOS-based application to a windows environment in order to take advantage of more powerful equipment. Marks, on the other hand, discloses that it is well known in the art to port a Windows application to the World Wide Web in order to take advantage of the Internet. Thus, the Examiner strongly disagrees with the Applicant's argument that the Visual Configurator of IBM

teaches away from the feature of claim 1 since porting an application from one environment to another environment is an obvious modification. If the Applicant decides to maintain this argument then the Examiner requests the Applicant to provide evidence to support this position. For this reason, the examiner maintains the art rejection.

Finally, the Applicant has argued that the rejection under non-functional descriptive matter is improper. The Examiner respectfully disagrees because the "measurement system" does not play any part in the claims whatsoever.

### ***Conclusion***

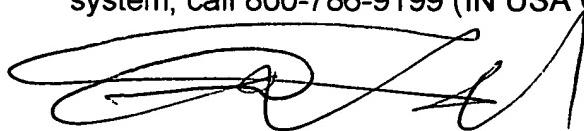
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

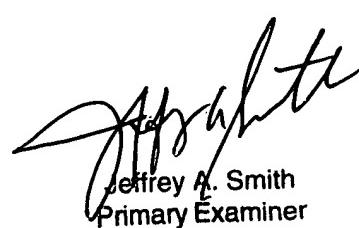
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Naeem Haq**, Patent Examiner  
Art Unit 3625

July 18, 2006



Jeffrey A. Smith  
Primary Examiner